

REMARKS

Claims 1-42 are currently pending in the subject application and are presently under consideration. Claims 17-42 have been withdrawn pursuant to the Examiner's restriction requirement. Applicants' representative affirms the election of Group I (claims 1-16), with traverse, for further prosecution on the merits; and intends to pursue the withdrawn claims in divisional applications. In addition, the specification has been amended as indicated at pg. 2 of this reply to address objections to the title and abstract. Moreover, a replacement drawing sheet is submitted herewith to address minor informalities with a figure. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-16 Under 35 U.S.C. §101

Claims 1-16 stand objected to under 35 U.S.C. §101 because the examiner contends that the claims are drawn to "software *per se* that is not tangibly embodied on a computer readable medium and therefore lacks a practical application because it alone cannot produce its intended outcome." (Office Action at page 5). Applicants' representative respectfully submits that this rejection should be withdrawn for at least the following reasons. The subject claims clearly recite statutory subject matter. The subject claims recite systems that produce a *tangible, useful result* and are patentable subject matter.

Patentable subject matter is defined by 35 U.S.C. § 101, which provides as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The Federal Circuit has held that the focus of the inquiry regarding whether a claim encompasses patentable subject matter is "not on whether there is a mathematical algorithm at work, but on whether the algorithm-containing invention, as a whole, produces a *tangible, useful result*." (*AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1361 (Fed.Cir. 1999)) (emphasis added). In *AT&T v. Excel*, the patent at issue described a message record for long-

distance telephone calls that included a primary interexchange carrier (“PIC”) indicator that allowed for differential billing treatment for subscribers. (*See AT&T*, 172 F.3d at 1353). AT&T’s claimed invention utilized Boolean algebra “to determine the value of the PIC indicator, and [applied] that value through switching and recording mechanisms to create a signal useful for billing purposes.” (*See AT&T*, 172 F.3d at 1358). Relying on its holdings in *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), *cert. denied*, 525 US 1093 (1999) and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053 (Fed. Cir. 1992), the Court held that the AT&T process was patentable subject matter:

In *State Street*, we held that the processing *system* there was patentable subject matter because the *system* takes data representing discrete dollar amounts through a series of mathematical calculations to determine a final share price – *a useful, concrete, and tangible result*. *See* 149 F.3d at 1373, 47 USPQ2d at 1601. In this case, Excel argues, correctly, that the PIC indicator value is derived using a simple mathematical principle (p and q). But that is not determinative because AT&T does not claim the Boolean principle as such or attempt to forestall its use in any other application. It is clear from the written description of the ‘184 patent that AT&T is only claiming a process that uses the Boolean principle in order to determine the value of the PIC indicator. The PIC indicator represents *information* about the call recipient’s PIC, *a useful, non-abstract result* that facilitates differential billing of long-distance calls made by an IXC’s subscriber. Because the claimed process applies the Boolean principle to produce a *useful, concrete, tangible result* without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of Section 101. *See Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1060, 22 USPQ2d 1033, 1039 (Fed. Cir. 1992) (“That the product is numerical is not a criterion of whether the claim is directed to statutory subject matter.”). (emphasis added).

(*See AT&T*, 172 F.3d at 1358).

Applicants’ representative respectfully submits that the Federal Circuit’s decisions interpreting patentable subject matter under 35 U.S.C. §101 are controlling law on this issue. As noted *supra*, the Federal Circuit has held that systems and processes that produce *useful, concrete, and tangible results* are patentable. (*See AT&T*, 172 F.3d at 1361 and *State Street*, 149

F.3d at 1373). The systems of the subject claims gather and aggregate operational metrics of a plurality of members configured as an entity. The systems serve to greatly facilitate management and administration of the entity by automating system information retrieval, which is a ***useful, concrete, and tangible result*** that saves time and administration costs. (*See e.g.*, Application at p. 6, lines 6-17).

The examiner contends that claims 1-16 are non-statutory because these claims are to “software *per se* that is not tangibly embodied on a computer readable medium and therefore lacks a practical application because it alone cannot produce its intended outcome.” (Office Action at page 5). Applicants’ representative respectfully disagrees with this contention. Claim 1 is drawn to a ***system*** for gathering and aggregating operational metrics of a plurality of ***members*** configured as an ***entity***. (*See Application at page 22*). The subject claims include the limitation that at least one of the ***members*** is adapted to gather operational metric data and aggregate the data into a unified result set. (*See Id.*). Members may be, but are not limited to, for example, computers, servers, and machines. (*See Application at p. 6, lines 25-27; p. 8, lines 2-8; and Figure 1 members 22a through 22d*). These ***members*** are adapted to produce the intended ***useful, concrete, and tangible result*** – gathering and aggregating operational metrics. In accordance with Federal Circuit precedent, systems producing a ***useful, concrete, and tangible result*** are patentable. (*See State Street*, 149 F.3d at 1373; *see also AT&T*, 172 F.3d at 1360-61).

In view of at least the foregoing, claims 1-16 encompass patentable subject matter. Applicants’ representative respectfully submits that the examiner withdraw the objection.

II. Rejection of Claims 1-4, 6, 7, 9-14, and 16 Under 35 U.S.C. §102(e)

Claims 1-4, 6, 7, 9-14, and 16 stand rejected under 35 U.S.C. §102(e) as being anticipated by Teegan *et al.* 6,748,555 (“Teegan *et al.*”). This rejection should be withdrawn for at least the following reasons. Teegan *et al.* does not teach or suggest ***each and every element*** of the claimed invention. In particular, Teegan *et al.* does not teach or suggest a gathering and aggregating system adapted to gather operational metrics relating to ***system level*** operation.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that “*each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added).

Independent claim 1 is directed toward a system for gathering and aggregating operational metrics of a plurality of members configured as an entity. (See Application at p. 22). The operational metrics relate to *system level* operation and include but are not limited to data on system performance, system status, system health, system state, and system events associated with the plurality of members. (See e.g., Application at p. 3, lines 1-4; p. 6, lines 23-25; p. 8, lines 21-29; and p. 9, lines 1-2). In contrast, Teegan *et al.* discloses a system for processing information relating to software programs, but does not teach or suggest gathering and aggregating operational metrics that relate to *system level* operation.

To support the rejection, the examiner cites to the abstract of Teegan *et al.* and contends that the abstract discloses the limitations of claim 1. (See Office Action at p. 6). Applicants’ representative respectfully disagrees. Neither the abstract nor any of the other sections cited by the examiner teach or suggest gathering and aggregating operational metrics that relate to *system level* operation. Teegan *et al.* discloses the processing of information relating only to software programs. For the foregoing reasons, Teegan *et al.* does not teach or suggest operational metrics as recited in claims 1-16. Accordingly, this rejection should be withdrawn.

III. Rejection of Claims 5, 8 and 15 Under 35 U.S.C. §103(a)

Claims 5, 8 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Teegan *et al.* in view of “Official Notice”. Applicants’ representative respectfully submits that this rejection should be withdrawn for at least the following reasons. The Teegan *et al.* patent and the subject patent application are commonly owned by Microsoft Corporation and the applicants were under an obligation of assignment to Microsoft Corporation at the time the subject invention was made. For this reason, Teegan *et al.* cannot be used to preclude patentability under 35 U.S.C. §103. (See 35 U.S.C. §103(c)). Hence, this rejection should be withdrawn.

Moreover, claims 5, 8, and 15 depend from claim 1, and thus are allowable for at least the same reasons noted above in connection with claim 1. Hence, this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

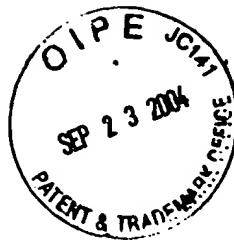
Respectfully submitted,

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REPLACEMENT SHEET

Title:

Title: DISTRIBUTED DATA GATHERING AND
AGGREGATION AGENT
Inventor(s): Federico Garcea, et al.
Serial No. 09/710,172
Docket No. MS154756.01/MSFTP125US

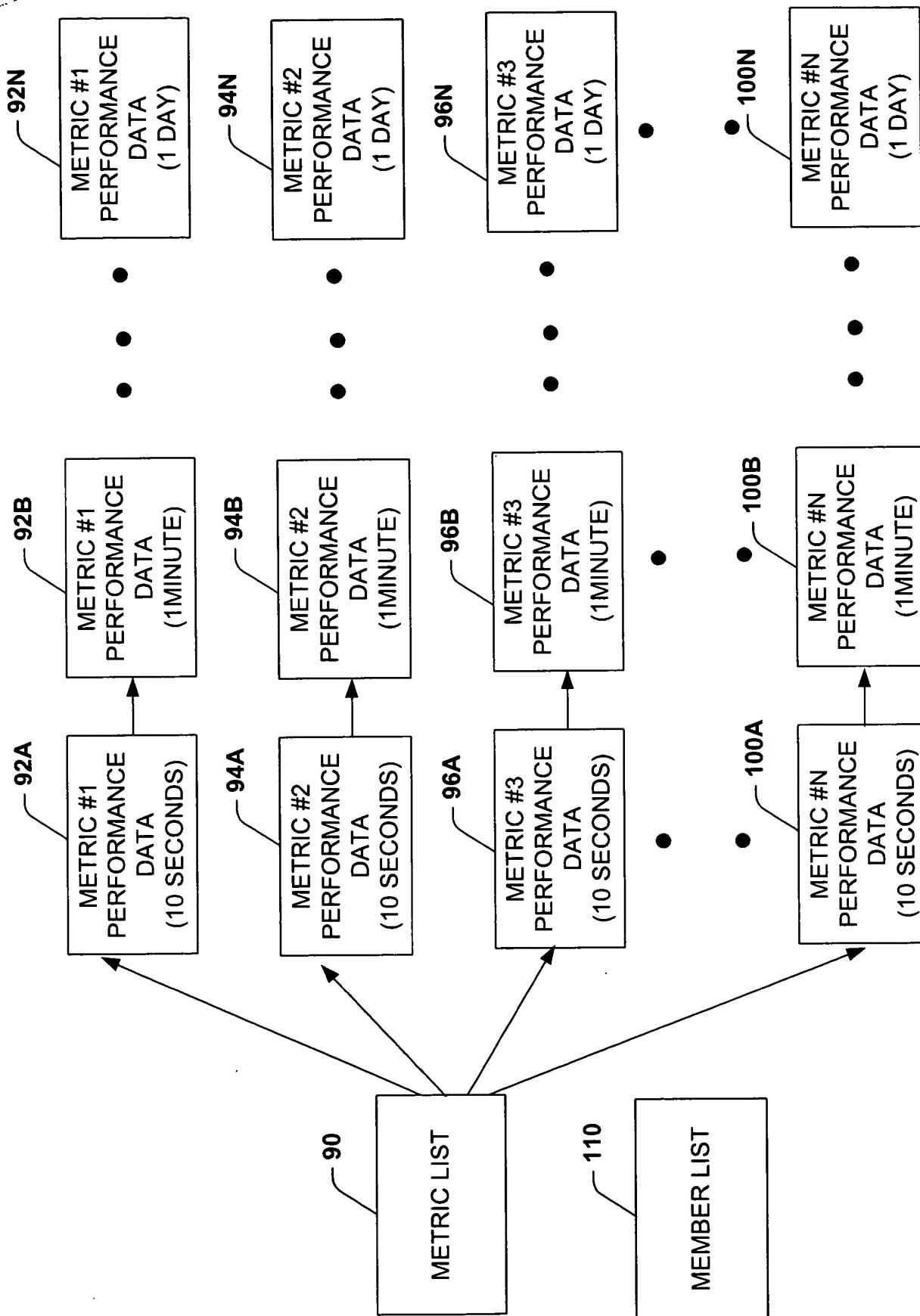


Fig. 5